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OCT 23 2006

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Examiner: **John D. Walters**Appellant: **Nick Bromer**GAU: **3618**Title: **DORSIFLEXION SKATE BRAKE**Serial No.: **09/995,097**Filed: **Nov. 27, 2001**This paper: **October 23, 2006****BRIEF ON APPEAL**Commissioner for Patents
P.O. Box 1450, Alexandria, VA 22313-1450
Sir:

A Notice of Appeal was submitted on August 21, 2006. This paper is submitted on the Monday following the two-month date, which was on Saturday, October 21, 2006, so this paper is timely submitted.

No fee is due for this Brief because the Examiner reopened prosecution; the attached payment covers the increase in the fee since the last Brief was filed in this case (see MPEP §1207.04, ¶12.187(2)). The Appellant paid \$160 with the Brief of December 12, 2002, and the fee is now \$250, so the difference of \$90 is now paid.

REAL PARTY IN INTEREST

The real party in interest is Nick Bromer.

RELATED APPEALS AND INTERFERENCES

This same application has been appealed before (Appeal No. 2005-0040). The Board allowed claims (Decision mailed September 19, 2005, attached hereto as an appendix). The Appellant was satisfied and put the allowable claims into condition for allowance (Amendments of October 3 and October 13, 2005). However, the Examiner would not issue a notice of appeal and reopened prosecution. Lacking an efficient way to appeal the reopening, the Appellant then drafted new claims in an effort to resolve what appeared to be the Examiner's issues with the claims which the Board had stated to be allowable (Amendments of March 7 and March 27, 2006).

Adjustment date: 10/24/2006 EFLORES
12/13/2002 RWDNAF1 00000075 09995097
01 FC:2402 -160.00 OP

10/24/2006 EFLORES 00000003 09995097

1

01 FC:2402 250.00 OP

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(mistakenly "2005" in the headings)). However, the Examiner then rejected again. Due to the Examiner's actions the Appellant, and the Board, are now forced to revisit this case.

There are no currently-pending related appeals or interferences.

STATUS OF CLAIMS

Claims 5 and 28-40 are pending. Claims 5 and 28-29 and 30-40 are rejected, claim 30 is objected to, and claims 1-4 and 6-27 are canceled. All the rejected claim are being appealed.

STATUS OF AMENDMENTS

No amendments have been made since the final rejection. The last claim amendment was March 27, 2006.

SUMMARY OF CLAIMED SUBJECT MATTER

Independent claim 5 recites

For a user having a foot with a toe and standing on a skate, the skate including a position for the foot; a skate braking mechanism comprising:

The user's toe is recited in the preamble because the toe's upward motion ("dorsiflexion" is the medical term for it) is the basis of the Appellant's invention. The foot has a position in which the toe is under a lifter (recited in portions of the claim below). Fig. 1 shows a boot B (page 7, line 27), which is a device that locates the user foot at a position. The claim next recites

a brake;

The brake can be of various forms. Preferably, it has a brake shoe that bears against one of the skate wheels (Fig. 1) rather than against the ground (Fig. 2). There are two versions with the brake shoe bearing against the wheel. Fig. 1 shows a one-piece combined brake shoe and lifter, and Fig. 3 shows a brake shoe that is coupled to a lifter by a linkage. In more detail:

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The embodiment of Fig. 1 is the simpler embodiment because there are no linkages in the braking mechanism, only a one-piece arm 100 that includes both the brake shoe and a toe lifter (the portion 110 under the user's toes, above the front wheel W1). An in-line type of skate is shown, with tandem wheels W1, W2, ... mounted on a truck T. The arm 100 is pivoted on either side of the wheel W2 by a pin 130 that is coaxial with the second wheel W2 (page 7, lines 23-25); this is a convenient position because the axle of wheel W2 can double as the hinge pin 130.¹

Hinging the arm 100 at the pin 130 provides extra braking force (page 8, lines 11-15). Also providing extra braking force is the shape of the brake shoe 150, which preferably has a toroidal double curvature to mate with the surface of the wheel W1 (page 8, lines 6-10). The increased mechanical efficiency relates to the issues of this case, as discussed below.

In Fig. 1 the shading lines on the portion of the arm 100 above the hinge pin 130 indicate bends in the arm. These bends are described at page 8, line 19. The widening makes the arm wide enough at the toe cap 110 to accommodate the toes, but it cannot be as wide as the toes at the level of the brake shoe 150, or else the arm 100 would scrape the ground while turning a corner (when the skates are laterally inclined). At the bottom, there is no reason for the arm extension 140 or the brake shoe 150 to be much wider than the wheel itself.

In Fig. 3, contact between the wheel W1 and the shoe 350 is by pulling up by a double-ended rod 320, which rotates the arm 340 about a hinge pin 130. When the rod 320 moves up, the small gap between the brake shoe 350 and the wheel W1 is closed and the wheel rubs on the brake shoe 350. Both ends of the rod 320 are attached to a lifter (not shown in Fig. 3; discussed below) that pulls up the arm 340 to engage the brake (page 10, line 11).

The rod 320 is shown cut away on the far side, and on the near side is shown cut away closer to the brake shoe so as not to obstruct the view of the other structures.

The embodiment of the brake shoe shown in Fig. 3 and labeled by reference numeral 350, uses urethane belting as a brake-shoe material (for reasons explained on page 10 of the specification).

¹ The axle of an in-line skate usually does not rotate; the axle protrudes from the sides of the wheel and the protruding parts are fixed to the truck, and the wheels have bearings pressed into them so that they can spin around the stationary axles.

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Claim 5 continues,

a lifter operatively coupled to the brake and pressable upward by a toe motion consisting of an upward rotation of at least one phalanx bone of the toe relative to at least one metatarsal bone of the foot, while the user's foot is on the position, the toe motion acting to actuate the brake;

In Fig. 1, the lifter is the toe cap 110 (as mentioned above). Other lifters disclosed in the specification include straps, and toe bars (page 7, lines 4-10). The arrow A in Fig. 1 shows the upward motion of the toe cap when the user's toe presses it up, which is a motion acting to actuate the brake.

The Board is invited to note that rotation of the phalanx (toe bone) relative to the metatarsal (instep bone, between the toes and the ankle) will result in the toes rising while the ball of the foot, the instep, the ankle, the heel, and the rest of the foot remain motionless on the ground.

Raising the toes is the only motion used in applying the brake. Because claim 5 uses "consisting of" language, the claimed brake is actuated by this motion *alone*. Other foot motions—for example, rotation around the ankle joint—are not covered by the claim language. A brake that is actuated by a rotation around the ankle joint is not within the scope of the claim.

The fact that the Appellant's brake is actuated by an upward motion of the toes is essential to the invention because the toes are instinctively lowered when a person starts to fall forward, which happens when the brakes are applied too hard. Therefore, the user will instinctively release the brake, by lowering the toes, at the right time. The honorable Board is invited to consider the Summary between page 4, line 21 and page 5, line 27, where the Appellant explains this idea. The Appellant's advantage is recited in the final paragraph of claim 5:

whereby the brake is actuated according to a motion of the toe, which is not contrary to a natural motion of the toe to maintain balance of the user.

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Dependent claim 28 is illustrated in Fig. 1, with wheels W1 and W2 mentioned above.

The brake shoe is shown in Fig. 1 as element 150 and is discussed at page 8, line 4.

The linkage of Fig. 3, discussed above, exemplifies the subject matter of claim 29.

Claim 30 recites direct coupling, which is shown in Fig. 1.

The subject matter of claims 31-34 is set out at page 10, lines 4 and 15, and in Fig. 3.

Claim 35 recites a return spring, which is exemplified by spring 370 in Fig. 3. The spring retracts the brake shoe from the wheel when the user's toes are lowered.

Claims 36-38 are supported as follows. A lifter position forward of the metatarsals of the foot (claim 36) is supported at page 7, lines 10-13, explaining that the lifter can be hinged at the phalanx-metatarsal joint, which, taken in conjunction with the drawing, places the lifter forward of the metatarsals. Claims 37-38 are supported by the same disclosure and the discussion above relative to claim 5.

Claim 39, reciting a pivot at a wheel axle, is supported in Figs. 1 and 3, as discussed above relative to claim 5 and at page 7, line 25.

Claim 40 recites the skate, which is shown in Fig. 1 and described throughout the specification.

GROUND OF REJECTION TO BE REVIEWED ON APPEAL

Claims 5, 28-29, 35-38, and 40 are rejected under §102 over Carlsmith 5,232,231 (previously considered by the Board).

Claims 5, 28-29, 35-38, and 40 are rejected under §103 over Carlsmith in view of TenEyck 5,569,629.

Claim 39 is rejected under §103 over Carlsmith in view of Hoskin 5,183,275.

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ARGUMENT: INDEPENDENT CLAIM 5

(1) The Examiner states (bottom of page 2) that Carlsmith discloses pressing the lifter by a motion consisting of² an upward rotation of the toe bone relative to a metatarsal bone (to which each toe bone is hinged). With respect, this is not correct. A toe motion *consisting of* an upward toe rotation would not activate Carlsmith's brake, and therefore would not meet the Appellant's claimed recitation "the toe motion acting to actuate the brake."

The Honorable Board is invited to consider:

"The improved design utilizes a boot and a frame ..." writes Carlsmith (col. 6, line 37), and also "The boot is attached to the frame via a hinge somewhat to the rear of the middle of the foot" (col. 6, line 45).³ This means that the hinge is near the *proximal* end of the metatarsals, far from the *distal* end which articulates with the toe bones. The hinge location is clearly shown in Carlsmith's drawing to be near the proximal end of the metatarsals,⁴ as is discussed further below.

Carlsmith's text at col. 9, lines 22-26 can be interpreted to mean that the boot, as well as the fame, is made of "glass reinforced nylon or similar material" and this interpretation is quite reasonable, since many skate boots are very stiff. Carlsmith's boot also includes "boot flanges 20L and 20R" (col. 9, line 36) along the sole, and these must be rigid, even if the rest of the boot is not, to support the user's instep while allowing the boot to rotate as a whole about hinge 23.

In any event, whether it is stiff or not, the boot moves as whole relative to the frame. "The boot 62 and the frame 15 are primarily connected with a hinge," says Carlsmith (col. 9, line 35). "Braking action ... is accomplished when the skater pushes down with his or her *heel* on the boot 62. The *boot* rotates on the hinge [pin 23]" (col. 10, line 7; emphasis added). "Thus when the skater rocks the boot of the skate backward, the pressure on the *heel* of the boot is translated into pressure on the brake pads The amount of braking can be effectively modulated by modulating the pressure applied to the *heel*" (col. 10, lines 59-68; emphasis added).

² The phrase "consisting of" excludes brake actuation by other toe motions. This was mentioned above.

³ The hinge pin is shaft 23, see Fig. 4 of Carlsmith.

⁴ The Honorable Board is referred to the Brief of December 12, 2002 for anatomical drawings of the foot.

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The Honorable Board is invited to consider further Carlsmith's Fig. 5, which shows a detent located not far from the toe/metatarsal joint. If the Carlsmith skater were to raise his or her toes in the manner that the Appellant claims, then the result would likely be a reaction *downward* pressure on the detent. But a downward pressure would be contrary to the disclosure of Carlsmith, who states that the user must push down with the *heel* to disengage the detent and allow braking (col. 12, lines 8-10). Thus, according to Carlsmith, the Appellant's toe motion would not result in braking.

In summary, a close reading of Carlsmith demonstrates that in Carlsmith's skate, raising the toes relative to the metatarsals—while doing nothing else⁵—would **not** result in braking. Therefore the Appellant's claimed "toe motion *consisting of* an upward rotation of at least one phalanx bone of the toe relative to at least one metatarsal bone of the foot, while the user's foot is on the position, *the toe motion acting to actuate the brake,*" is not anticipated.

(2) At the top of page 3 of the Office Action, the Examiner asserts that the axis of Carlsmith is adjacent to the metatarsal/phalanx joint. As is mentioned briefly above, this is respectfully submitted to be erroneous.

The Board is referred to Fig. 8-31 in the text pages attached to the Brief of December 12, 2002 (these text pages, already in the PTO file, are incorporated into this paper by reference), which shows the locations of the metatarsal/toe joints LMPJA, the ankle joint axis AJA, and the oblique midtarsal joint axis OMJA (the Honorable Board is invited to note that the OMJA axis is far dorsal of the metatarsal *bones*, as the figure shows). Carlsmith's drawing (Figs. 4 and 12) shows that its hinge shaft 23 (col. 9, lines 40-42) is, roughly, under the OMJA axis, and is arguably not under any part of the metatarsal bones, not even the dorsal ends of the metatarsals.

(3) At page 3, line 3 of the Office Action, the Examiner asserts that Carlsmith discloses brake actuation by a "natural" motion of the toe. This is true, but Carlsmith's "natural" motion is directly *opposite* to the Appellant's claimed "natural" motion.

⁵ Under the Appellant's "consisting of" language.

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Carlsmith states (col. 2, line 61) that "raising one's toes into the air while keeping one's heel on the ground [is] an unnatural motion for the foot." Carlsmith teaches against raising the toes relative to the heel (not relative to the metatarsal bones, as claimed—in the motion disclosed by Carlsmith, the metatarsals will also rise relative to the heel bone) at col. 2, line 58, and into the next column.⁶

The Appellant claims raising the toes relative to the metatarsals "while the user's foot is on the position," which implies that the heel, as well as the rest of the foot, is flat down; that is contrary to Carlsmith's teaching.

(4) The Examiner asserts that Carlsmith discloses a lifter (page 2, 7th line from the bottom). The Appellant respectfully disagrees.

Carlsmith discloses a boot. To arbitrarily isolate one portion of the boot and call it a "lifter," when the reference itself (1) does not isolate that portion for any purpose, (2) does not use the word "lifter" or apply that word to *any* portion of the boot, and (3) teaches contrary to using the arbitrary portion of the boot as a lifter (as argued above), is not supported in the reference.

(5) The Advisory Action of May 19, 2006. The Examiner states, "The preamble of claim 5 contains open claim language ["comprising"]. Therefore, movements in addition to 'a toe motion consisting ...' are considered to still read on the claim." This assertion is respectfully traversed. Claim 5 reads,

*For a user having a foot with a toe and standing on a skate, the skate including a position for the foot; a skate braking mechanism comprising:
a brake; and
a lifter operatively coupled to the brake and pressable upward by a toe motion consisting of an upward rotation of at least one phalanx bone of the toe*

⁶ Integnan, the reference formerly applied, teaches very strongly against braking by lifting the toes.

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relative to at least one metatarsal bone of the foot, while the user's foot is on the position, the toe motion acting to actuate the brake ...

(a) Clearly, the brake and the lifter are two elements of the claimed mechanism. However, a motion cannot be an element of a mechanism. To assert otherwise would be contrary to the PTO's own distinction between method and apparatus. Therefore, "mechanism comprising" in the preamble does not limit the recited motion, because only a mechanism element can be added by "comprising."

If no weight is given to "consisting of" as the Examiner proposes, then the claim would read, *a skate braking mechanism comprising: a brake ... a lifter .. and ... a toe motion*. With respect, that is not a consistent interpretation. "Consisting of" cannot be brushed aside without rendering the claim both senseless and contrary to §101.

(b) There are two transitional phrases, one nesting inside the other. The Appellant believes that claim construction dictates that the second transitional phrase cover what follows it, rather than to act as if "consisting of" were not even in the claim and let "comprising" run over all that follows.

(c) MPEP § 2111.03 states, "When the phrase 'consists of' appears in a clause of the body of a claim, rather than immediately following the preamble, it limits only the element set forth in that clause." The MPEP does *not* say the phrase "consists of" does *not* limit what follows. Indeed, that is believed to be logically contrary to what the MPEP says.

(d) MPEP § 2111.01 states that the claim must be given its "plain meaning" and the plain meaning of the Appellant's claim is what it plainly means, that the motion is restricted to the recited upward rotation. With respect, the Examiner's interpretation is strained.

(e) Furthermore, the Examiner's asserted interpretation is contrary to the Appellant's disclosure and arguments and to the file history.

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ARGUMENT: CLAIM 36

No lifter positioned forward of the metatarsals is disclosed by Carlsmith. As discussed above, the user's toe is encased in a boot and no toe motion can actuate anything, so there is no toe "lifter."

ARGUMENT: CLAIM 37

Still less is there any toe lifter that is pivoted.

ARGUMENT: CLAIM 38

Likewise, there is no disclosure of a toe lifter that is pivoted near the toe bone joint.

ARGUMENT: CLAIMS 31-34

Claims 31-34 were rejected under §103 over Carlsmith in view of TenEyck. This rejection is argued on the following grounds:

Carlsmith shows cylindrical disks on the sides of its wheels, and the brake shoes bear on the circumferences of these disks, called "brake drums 41" (col. 11, line 16). Thus, the Examiner's proposed motivation to avoid heat "caused by ... skating on hot surfaces" (page 3, last line) is not supported in the reference, because the brake parts do not touch the ground. Furthermore, the assertion of high temperatures is respectfully submitted to be unsubstantiated. The amounts of energy involved in skating are believed to be insufficient to cause very high temperatures; the Appellant has never seen a skate brake smoking.

ARGUMENT: CLAIM 39

Claim 39 was rejected under §103 over Carlsmith in view of Hoskin. This rejection is argued for on the following grounds:

Hoskin does not disclose "a brake shoe that is pivoted to rotate about an axle of a first wheel, so as to bear against a second wheel." Hoskins discloses a brake shoe ("ground-engaging brake pad 64p," col. 5, line 46) that is pivoted to rotate about an axle of a first wheel (23w), so as to bear against *the ground*. The brake shoe 64p of Hoskin does not bear against any wheel. The

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Examiner applies roller 82r as anticipating another wheel, but this is traversed; it is a "roller" and not a "wheel" like wheel 23w, according to the terminology of Hoskin itself. Neither is it a brake shoe, because it is in "non-slipping, rolling contact" with the wheel 23w (col. 7, lines 1-10), and if it were a brake shoe it would be in rubbing contact.

Furthermore, both references disclose different complicated mechanisms for the same purpose, braking, and this teaches against combination. Furthermore, the Appellant sees no expectation of success—it is not even clear *how* these mechanisms should be combined (not admitted).

The proposed motivation, to minimize brake wear, is respectfully traversed. Hoskin teaches dragging the brake shoe on rough cement (instead of Carlsmith's smooth brake drum 41) and therefore does not teach minimizing brake wear. If Carlsmith were to adopt Hoskin's teaching and put the brake pad against the ground, it would wear out more quickly, not less.

ARGUMENT: CLAIMS 28-30, 35, and 40

These claims are argued based on dependence from allowably claims.

Respectfully submitted,

Nick Bromer

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*I certify that this correspondence is being facsimile transmitted to the United States
Patent and Trademark Office (fax no. 571-273-8300) on October 23, 2006.*

Nick Bromer [reg. no. 33,478]

Signature *Nick Bromer*

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CLAIMS APPENDIX

1-4. (canceled)

5. (previously presented): For a user having a foot with a toe and standing on a skate, the skate including a position for the foot; a skate braking mechanism comprising:

a brake; and

a lifter operatively coupled to the brake and pressable upward by a toe motion consisting of an upward rotation of at least one phalanx bone of the toe relative to at least one metatarsal bone of the foot, while the user's foot is on the position, the toe motion acting to actuate the brake;

whereby the brake is actuated according to a motion of the toe, which is not contrary to a natural motion of the toe to maintain balance of the user.

6-27. (canceled)

28. (previously presented): The skate braking mechanism according to claim 5, wherein the skate includes at least one wheel and the brake comprises a brake shoe coupled to the lifter, and wherein the brake shoe bears on the wheel of the skate when actuated.

29. (previously presented): The skate braking mechanism according to claim 28, wherein the brake shoe is coupled to the lifter via a linkage.

30. (previously presented): The skate braking mechanism according to claim 28, wherein the brake shoe is directly coupled to the lifter.

31. (previously presented): The skate braking mechanism according to claim 28, wherein the brake shoe comprises fiber-reinforced elastomer.

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32. (previously presented): The skate braking mechanism according to claim 31, wherein the brake shoe comprises a portion of fiber-reinforced elastomer belt.

33. (previously presented): The skate braking mechanism according to claim 31, wherein the elastomer comprises urethane.

34. (previously presented): The skate braking mechanism according to claim 28, wherein the brake shoe comprises urethane.

35. (previously presented): The skate braking mechanism according to claim 5, comprising a return spring counteracting an upward pressing motion of the toe.

36. (previously presented): The skate braking mechanism according to claim 5, wherein the lifter is positioned above the toe forward of the metatarsals of the foot of the user.

37. (previously presented): The skate braking mechanism according to claim 5, wherein the lifter is pivoted to be moved upward by the toe.

38. (previously presented): The skate braking mechanism according to claim 37, wherein the lifter is pivoted about a pivot axis adjacent to a joint between the metatarsal bone and the phalanx bone.

39. (previously presented): The skate braking mechanism according to claim 5, wherein the skate includes wheels and the brake comprises a brake shoe that is pivoted to rotate about an axle of a first wheel, so as to bear against a second wheel.

40. (previously presented): The skate braking mechanism according to claim 5, comprising the skate.

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EVIDENCE APPENDIX

There is no evidence to submit.

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RELATED PROCEEDINGS APPENDIX

A copy of the Board Decision follows.

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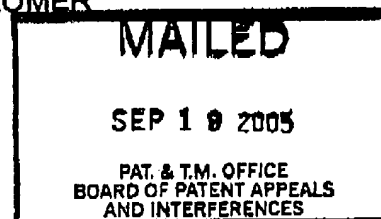
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The opinion in support of the decision being entered today was not written
for publication and is not binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**Ex parte NICK (NICHOLAS SHEPPARD) BROMER

Appeal No. 2005-0040
Application No. 09/995,097

HEARD: May 18, 2005



Before PATE, MCQUADE, and BAHR, Administrative Patent Judges.
PATE, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal from the final rejection of claims 2, 3, 5, 6, 9, and 11-16 and the examiner's refusal to allow claim 17 as amended after final rejection. Claims 4, 7 and 10 stand withdrawn from consideration as subject to a restriction requirement. The appeal with respect to claim 8, the only other remaining claim in the application, was withdrawn by the appellant at the oral hearing. These claims comprise all the claims remaining in the application.

The claimed subject matter is directed to a skate having a braking mechanism that is actuated by movement of the skater's toe in the upward direction.

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Claim 2, reproduced below, is further illustrative of the claimed subject matter.

2. For a user having a toe and standing on a skate, a skate braking mechanism comprising:

a brake; and

a lifter connected to the brake and pressable upward by the toe of the user to actuate the brake;

whereby the brake connected to the lifter is actuated according to a natural motion of the user to maintain balance.

THE REFERENCES

The references of record relied upon by the examiner as evidence of anticipation and obviousness are:

Carlsmith
Intengan

5,232,231
6,053,511

Aug. 3, 1993
Apr. 25, 2000

THE REJECTIONS

Claims 2, 3, 5, 6, 9, and 11-17 are rejected under 35 U.S.C. § 112, first paragraph. According to the examiner, these claims contain subject matter which was not set out in the specification in such a way as to enable one skilled in the art to make and use the invention.

Claims 2, 3, 12 and 16 stand rejected under 35 U.S.C. § 102(b) as anticipated by Intengan.

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Claim 16 is rejected under 35 U.S.C. § 102(b) as anticipated by Carlsmith.

The appeal of the rejection of claim 8 was withdrawn by appellant during oral argument at final hearing.

OPINION

We have carefully reviewed the rejections on appeal in light of the arguments of the appellant and the examiner. As a result of this review, we have determined that the 35 U.S.C. § 112, first paragraph rejection of all claims on appeal is not well founded. Additionally, we affirm the 35 U.S.C. § 102 rejection of claims 2, 3 and 12 as anticipated by Intengan and the rejection of claim 16 as anticipated by both Intengan and Carlsmith. Our reasons follow.

Turning to the rejection of 35 U.S.C. § 112, it appears that the examiner's main objection is that the disclosure including the Figures does not make it evident how brake arm 140 can be outside the plane of the wheels where it attaches to pivot 130 and still be in a plane to engage front wheel W1. We are in agreement with the appellant that based on the drawing and the disclosure on pages 7 and 8 of the specification, one of ordinary skill would be able to manufacture and use the claimed subject matter without undue experimentation. We are of the view that the manufacture of the braking mechanism of Figure 1 is well within the ordinary skill in this art.

Turning to the anticipation rejections, we will sustain the rejection of claim 2 based on the lack of novelty over the Intengan reference and the claims rejected

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therewith. It is our finding that Intengan discloses a brake for an inline skate. The skate has a boot 44 rigidly mounted to a base 52A on which a plurality of inline wheels 57, 58, 59, 60 are mounted for rotation. A liner in the boot is provided with an opening in order to allow the skater's foot to articulate at will to affect the braking. The change in foot position shown in Figures 2A and 3A shows how braking is actuated. We note from the Figures, that as the foot is arched, the rear of the toe is correspondingly lifted to actuate the brake. In our view, this fully satisfies the functional language of appellant's claim.

Moreover, in our view, the only structure called for in appellant's claim 2 is that of a lifter connected to the brake. Note that the lifter is merely described as pressable upward. In our view, this is a clear example of a claim limitation directed to things which may or may not be done. See In re Collier, 397 F.2d 1003, 158 USPQ 266, 268 CCPA 1968.

Additionally, we are cognizant of the argument made by the examiner that the appellant on page 12 of specification states that the invention contemplates activation by any lifting action of the front portion of the foot. This lifting of the front portion of the foot is exactly what Intengan describes.

Accordingly, we sustain the anticipation rejections of claims 2, 3, 12 and 16 under 35 U.S.C. § 102 as anticipated by Intengan.

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Turning to claim 16, we note that the claim requires a brake and a means for actuating the brake by pressing upwardly the toe of the user. Carlsmith discloses an inline skate wherein the boot is pivotable about axle 23 with respect to the frame which mounts the wheels. When the user rocks his or her foot by moving the toes upwardly and the heel downwardly the brake of Carlsmith is actuated. Accordingly, we agree with the examiner that the disclosure of Carlsmith anticipates the subject matter of claim 16.

SUMMARY

The rejection of all claims on appeal under 35 U.S.C. § 112, first paragraph is reversed.

The rejection of claims 2, 3, 6, 12 and 16 under 35 U.S.C. § 102 as anticipated by Intengan is affirmed.

The rejection of claim 16 under 35 U.S.C. § 102 as anticipated by Carlsmith is affirmed.

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No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED-IN-PART


WILLIAM F. PATE, III
Administrative Patent Judge


JOHN P. MCQUADE
Administrative Patent Judge


JENNIFER D. BAHR
Administrative Patent Judge

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